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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,139	08/06/2003	Michael G. Harwell	3039.NWN	8403

7590

10/13/2006

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EXAMINER

SZEKELY, PETER A

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/635,139

Applicant(s)

HARWELL ET AL.

Examiner

Peter Szekely

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/5/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification only names tradenames as odor neutralizing materials. These tradenames signify proprietary, i.e. undisclosed chemical compositions. The chemical composition of and the method of manufacturing of these materials are not disclosed and are unknown. There is no mention of alternative materials. If for some reason these proprietary materials were not available, one of ordinary skill in the art, at the time the invention was made, would be unable to secure these materials, or reasonable substitutes thereof, and thus would be unable to practice the invention. A composition or a method based on trade secrets or undisclosed, proprietary compositions cannot be patented. The rejection is maintained.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 4, 5, 14, 15 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject

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matter which applicant regards as the invention. Claims 4, 5, 14, 15 and 24 contain the trademarks/trade names Quest Fragrance Q-29071 and Quest Fragrance Q-29072.

Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe proprietary odor neutralizing materials and, accordingly, the identification/description is indefinite. Applicants' arguments about the "Q numbers" not being tradenames have been considered, however no proof has been supplied. Applicants are requested to show the claimed compositions either in the Merck Index or the Aldrich Catalog in order to prove that said "Q numbers" are known chemical compositions. The rejections are maintained.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1, 7, 9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson 6,171,345, in view of Catron et al. 4,340,402 or Lakatas et al. 4,105,423.

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7. Johnson discloses an adhesive, which has an odor neutralizing feature in column 3, lines 21-23. The composition of the odor neutralizer is not disclosed. Neither is the composition of the odor neutralizer disclosed in any of the rejected claims. If there were no malodor the odor neutralizer would not be used. That is what optional feature means. The rejection is maintained.

8. Claims 1-3, 6-13 and 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vick et al. 5,861,128, Svenningsen et al. 6,664,309, Sharak 2002/0105183, Sekisui Chem. Co. JP-3-170575, Univ. Jilin CN 1401724, Yazaki Corp. JP-2002-180026 or Hitachi Kasei Polymer Co. JP-2000-204334.

9. Vick et al. teach a liquid fragrant in a hot melt adhesive in claims 1-3 and Examples II and III. Svenningsen et al. recite a hot melt adhesive containing a bacteriostat, which eliminates odor-causing bacteria. See claim 1 and column 1, lines 43-55. Sharak divulges scented materials in a hot melt adhesive in claims 1-13. Sekisui reveals cyclodextrin in a hot melt adhesive (Abstract). Univ. Jilin displays nano-sized fillers in a hot melt adhesive (Abstract). Yazaki describes carbon-carrying acid clay in an adhesive (Abstract). Hitachi discusses a metal deactivator in a hot melt adhesive (Abstract). Since the chemical composition of the odor neutralizers used by applicants is not disclosed by applicants' claims or specification, the examiner holds that any method of suppressing the odor of a hot melt adhesive is analogous to applicants' composition and/or method and as such it would have been obvious to one having ordinary skill in the art; at the time the invention was made, to use any of the materials and/or methods shown by the cited references to achieve applicants' results.

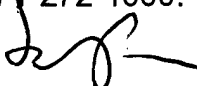
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10. If applicants were to disclose the chemical composition of the odor neutralizers used in the instant application, then issuing said application might become possible, provided no prior art had been found to prevent the patenting of the claimed invention.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (571) 272-1124. The examiner can normally be reached on 7:00 a.m.-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Peter Szekely
Primary Examiner
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